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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,533	08/27/2001	Gerd M. Muller	740105-78	2799

7590 04/20/2005

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EXAMINER	
FOREMAN, JONATHAN M	
ART UNIT	**PAPER NUMBER**
3736	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/938,533	MULLER ET AL.	
	Examiner	Art Unit	
	Jonathan ML Foreman	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *8,9,12-18 and 20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,10,11,19,21 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 6, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,788,711 to Lehner et al.

In reference to claims 1 – 6, 21 and 22, Lehner et al. discloses a partially implantable hearing system (Figure 1) comprising an electromechanical output transducer (6) selected from the group consisting of electromagnetic, electrodynamic, magnetostrictive, dielectric and piezoelectric transducers (Col. 8, lines 21 - 38); a micromanipulator (1) attached to a cranial vault (Col. 6, lines 24 – 26) for rotationally and axially positioning the transducer and for fixing the transducer in a set position (Col. 6, lines 41 - 53); a releasable coupling unit disposed between the transducer and the micromanipulator (Col. 7, lines 26 - 31). The releasable coupling comprises a transducer-side coupling element (15) and a micromanipulator-side coupling element (14) being adapted to selectively engage each other and disengage from each other. The micromanipulator-side coupling element receives the transducer-side coupling element. At least one of the coupling elements is

partially made of an elastic, soft polymeric material (Col 7, line 29). The releasable coupling unit enables the replacement of the transducer in the position set by the micromanipulator.

4. Claims 1 – 7, 19, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,325,755 to Bushek et al.

In reference to claims 1 – 7, 19, 21 and 22, Bushek et al. discloses a partially implantable hearing system (Figures 6 and 7) comprising an electromechanical output transducer (162) selected from the group consisting of electromagnetic, electrodynamic, magnetostrictive, dielectric and piezoelectric transducers (Col. 8, lines 40 – 43); a micromanipulator (147, 149, 150) attached to a cranial vault (Col. 10, lines 56 – 57) for rotationally and axially positioning the transducer and for fixing the transducer in a set position (Col. 12, line 66 – Col. 13, line 13); a releasable coupling unit disposed between the transducer and the micromanipulator (Col. 11, lines 36 – 65; Col. 12, lines 22 - 25). The releasable coupling comprises a transducer-side coupling element (168, 165) and a micromanipulator-side coupling element (135, 139) being adapted to selectively engage each other and disengage from each other. The micromanipulator-side coupling element receives the transducer-side coupling element (Col. 11, lines 38 – 41). At least one of the coupling elements is partially made of an elastic, soft polymeric material (Col 13, lines 13 – 29). The transducer-side coupling element is shown to be rotationally symmetrical. The releasable coupling unit enables the replacement of the transducer in the position set by the micromanipulator. Furthermore, it is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, i.e., a functional limitation, does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. ***In re Pearson***, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); ***In re Casey***, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); ***In re Otto***, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). Where the prior

art reference is inherently capable of performing the function described in a functional limitation, such functional limitation does not define the claimed apparatus over such prior art reference, regardless of whether the prior art reference explicitly discusses such capacity for performing the recited function. ***In re Ludtke***, 441 F.2d 660, 169 USPQ 563 (CCPA 1971).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,788,711 to Lehner et al. in view of U.S. Patent No. 5,935,170 to Hakansson et al.

In reference to claims 10 and 11, Lehner et al. discloses a releasable coupling unit where the micromanipulator-side coupling element defines a rigid annular receiver and the transducer-side coupling element is at least partially elastic (Col. 7, lines 26 – 31). However, Lehner et al. fails to disclose the releasable coupling being a snap-in coupling. Hakansson et al. discloses a partially implanted hearing aid (Col. 1, lines 6 – 13) wherein the releasable coupling affixed to the cranial vault is a snap-in coupling having a rigid annular receiving member, and the coupling element associated with the hearing aid is made partially elastic and adapted to snap into the rigid annular receiver member in a substantially axial direction (Figure 2; Col. 3, lines 18 – 22). It would have been obvious to modify the releasable coupling unit as disclosed by Lehner et al. to include a snap-in configuration the as taught by Hakansson et al. in order to provide a releasable coupling unit that prevents the need for large connection and disconnection forces (Col. 1, lines 30 – 50).

Response to Arguments

7. Applicant's arguments filed 3/18/05 have been fully considered but they are not persuasive. Applicant has asserted that the releasable coupling unit as disclosed by Bushek et al. does not enable the replacement of the transducer in the position set by the micromanipulator prior to removal of the transducer without readjustment of the micromanipulator. Applicant states that when replacing the transducer of Bushek et al., the releasable coupling must be removed along with the transducer requiring adjustment in order to reposition the transducer. The Examiner agrees that adjustment of the releasable coupling unit (168, 165; 135, 139) is necessary to reposition the transducer after removal. However, the position set by the micromanipulator (147, 149, 150) need not be influenced by the removal of the releasable coupling unit (168, 165; 135, 139).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMLF